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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,828

11/26/2003

Andrea Piana

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9268

30743

7590

08/01/2006

WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.  
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RESTON, VA 20190

EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,828

Applicant(s)

PIANA ET AL.

Examiner

Erma Cameron

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 14, 79-90, 99, 105 and 107-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 14, 79-90, 99, 105, 107-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment and RCE*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of Claims 95, 99, 100, 102 and 104 under 35 U.S.C. 112, second paragraph, Is withdrawn because of the amendment filed 5/31/2006.

3. Claims 10, 14, 79-90, 105 and 108-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 79, line 2: it is not clear if “having” modifies “first substrate” or “second substrate” or both.

b) Claim 79, line 11: it is not clear if this second treatment vessel is the same or different from the second treatment vessel in line 7.

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c) Claim 85: there is no antecedent basis for “the step of treating the second substrate with the first excess portion” or for “the step of treating the second substrate with the first excess portion”. (Note that claim 79 says that the treating is with the depleted portions.)

d) Claims 87-90: it appears that “a” in line 1 of each claim should be “the” for proper antecedent basis.

e) Claim 89: it appears that this should be “second excess” and “second substrate”. Otherwise, the claim would be identical to claim 87.

f) Claim 105: it is not clear which applying step of claim 99 is meant.

g) Claim 105: it is not clear which plurality of fibers of claim 99 is meant.

h) Claims 108-109: it is not clear when the centrifuging step occurs.

i) Claim 10: it appears that the Markush group should end in “and”.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The rejection of Claims 91-98, 106 and 15 under 35 U.S.C. 112, first paragraph (“new matter”), is withdrawn because these claims have been canceled.

6. Claims 99, 105, 107-109 and 10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process for applying a flame retardant composition which is free of dye, does not reasonably provide enablement for a composition that contains dye. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

It appears that the composition being free of dye is a critical element of the claimed invention.

7. Claims 99, 105, 107-109 and 10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for applying a flame retardant composition to a substrate which is at least 5 weight percent nonthermoplastic material, does not reasonably provide enablement for a substrate that is not at least 5 wt % nonthermoplastic. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The rejection of Claims 10, 14-15, 79-80, and 83-106 under 35 U.S.C. 103(a) as being unpatentable over admitted state of the prior art taken in view of Rock (5156890) is withdrawn because of the amendment filed 5/31/2006.

10. The rejection of Claims 81-82 under 35 U.S.C. 103(a) as being unpatentable over admitted state of the prior art taken in view of Rock (5156890) and further taken in view of Inman (3944688) is withdrawn because of the amendment filed 5/31/2006.

***Response to Amendment***

11. The Declaration under 37 CFR 1.132 filed 5/31/2006 is sufficient to overcome the rejection of claims 10, 14-15, 79-106 based upon the admitted state of the prior art taken in view of other references.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ERMA CAMERON**  
**PRIMARY EXAMINER**

Erma Cameron  
Primary Examiner  
Art Unit 1762

July 31, 2006